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10/575,426	04/10/2006	Declan Patrick Kelly	NL031264	3750

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EXAMINER	
HARVEY, DAVID E	

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2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/575,426	KELLY, DECLAN PATRICK	
	Examiner	Art Unit	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7,9,10 and 13-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-7, 9, 10, and 13-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The examiner notes that the preamble of the instant claims, e.g., claim 1 for example, indicate that the claims are directed to a "playback device". In the Appeal Brief filed 2/9/2010, applicant argues that this "device" recitation is sufficient to distinguish the recited structure of the claims over the "playback system" described by the applied prior art of Newnam et al. [US 2003/0189668]. The examiner disagrees for either of the following reasons:

> A) A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
> As such, it is the examiner's position that the "playback device" recitation of the preamble is, at best, a recitation of intended use;
>
> B) The term "device" is defined by "The American Heritage Dictionary" as:
>
> > **"Something devised or constructed for a particular purpose, esp. a machine used to perform one or more relatively simple tasks."**
>
> As such, it is also the examiner's position the common meaning/definition of the "device" terminology does not exclude devised or constructed "system".

While the outstanding rejections have not been withdrawn, ***the Finality of the last Office action has been withdrawn*** in order to complete the record; i.e., to apply the "prior art" of record (i.e., Newnam et al) given the broadest reasonable reading/interpretation noted above.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al.

I. The showing of Newnam et al:

As is illustrated in Figure 2, Newnam et al describes a system that includes:

A) A television broadcast studio (@ 310) and broadcast server system (300) which includes:

1) Circuitry (@ 510 and 500) having a "***playlist***" located therein (@ 510) wherein the playlist:

a) Controls the play order in which specific television programs are provided (@ 520) as a television broadcast "***stream***", i.e., one including video, are produced (@ 520) and broadcast (@ 610) to respective user locations (e.g., @ 230,320); and

b) Generates "***event information***" (via @ 500);

2) Server circuitry (@ 200), comprised of a ***processor***, for receiving said event information provided "***from the playlist***" (i.e., via elements 510 & 500);

wherein:

a) The "playlist" (@ 510) is not included in the television data stream that is broadcast (@ 310); and

b) Event information is changeable without changing the data stream.

[Note: paragraph 0012 and, significantly, lines 11-15 thereof; and paragraphs 0028, 0029, 0033, 0034, 0036, and 0037].

II. Differences:

Claim 1 differs from the showing of Newnam et al only in that claim 1 recites an "application for providing functionality associated with the event information".

III. Obviousness:

It is noted that each of the server circuitry (@ 200) and the circuitry at the user locations (@ 230, 320) in Newnam et al:

A) Are described as software driven processors (e.g., computers); and

B) Are described as providing an "interactive functionality" (e.g., the generation and display of an interactive content) associated with the event information.

The examiner maintains that it would have been obvious to one of ordinary skill in the art that this "functionality" is provided by an "application" of the software running on the software driven processors.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1. Additionally:

Note: the last seven lines of paragraph 0010; and paragraph 0034.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 3. Additionally:

The "mark" is at least a link mark in that it links/synchronized the ITV content with the broadcast stream.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 3. Additionally:

The "mark" is at least a link mark and is "reserved" for use by the application.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 6. Additionally:

The "mark" is at least a link mark and is "reserved" for use by the application and, as addressed above, may includes various types of information (i.e., "further information").

8. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1.**

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 9. Additionally:

Note: the last seven lines of paragraph 0010; and paragraph 0034.

10. **Claim 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1.**

11. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 14. Additionally:**

The examiner maintains that one can implicitly place/schedule an event at any location of a program, i.e., segment of the stream, including the start of said program.

12. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1. Additionally:**

The examiner maintains that one can implicitly place/schedule an event at any location of a program, i.e., segment of the stream, including the start of said program.

13. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1. Additionally:**

> The examiner takes Official Notice that it was well known in the art to have retrieved such event information prior to the occurrence of the event to account for processing delays. It would have been obvious to one of ordinary skill in the art to have modified Newnam in this well known fashion.

14. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 17.**

15. **Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1.**

16. **Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1.**

17. **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 1. Additionally:**

> The processor “monitors” the playback of the stream via elements 500 and 510.

18. **Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 9. Additionally:**

> The examiner takes Official Notice that it was well known in the art to have retrieved such event information prior to the occurrence of the event to account for processing delays. It would have been obvious to one of ordinary skill in the art to have modified Newnam in this well known fashion.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 9.

19. **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent document 2003/0189668 to Newnam et al for the same reasons set forth above with respect to claim 9. Additionally:**

The processor “monitors” the playback of the stream via elements 500 and 510.

20. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al.

A) Applicant's admitted "prior art":

On page 1 of the instant specification as originally filed, applicant appears to describe a conventional interactive payback device which comprised:

a) A interactive "Java" processing device for receiving event information that is embedded in an audio and or video data stream that is being provided/played by a set top box according to a predetermined playlist.

B) Differences:

Claim 1 appears to differ from the admitted prior art of the instant specification in that, as claimed, the event information is provided to the processing device by the playlist (as opposed to being provided within the data stream itself).

C) The showing of Newnam et al & obviousness:

As addressed above (note paragraph 3 of this Office action), Figure 2 of Newnam et al illustrates an interactive playback system in which interactive event/trigger information (e.g., @ 505) is provided to an interactive processor (e.g., @ 200) directly from a playlist (e.g., @ 510) that is used to play audio and/or video from a storage device (e.g., @ 520). The examiner notes that, like applicant's own invention, Newnam et al explicitly recognized that such a configuration simplified the production of an interactive presentation over "prior art" systems in which the event/trigger information was embedded in the audio and/or video stream itself.
[Note paragraphs 0002, 0005, 0006, and 0010-0012].

The examiner maintains that it would have been obvious to one of ordinary skill in the art to have modified the admitted prior art of the instant specification in accordance with the teachings of Newnam et al in view that Newnam et al solved the same "problem" in an analogous environment. Namely, it would have been obvious to have modified the admitted prior art so as to provided the event/trigger information from the playlist as opposed to embedding it within the data stream.

****

With respect to the argument filed 2/9/2010:

The examiner maintains that applicant's arguments mischaracterize the operations and teachings of the Newnam et al prior art. For example, as explained above, the playlist in Newnam et al is clearly not part of the broadcast stream as appears to have been alleged.

21. Claims 3-7, 13-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 1. Additionally:

The examiner maintains that the claims are broad (i.e., the terminology used therein is not specifically defined) and, as such, fail to distinguish the claimed system over the prior art in which the processor is controlled to operate in synchronism with the playback of the A/V data stream via timing information provided by the playlist. More specifically, as disclosed by of Newnam et al, the playlist includes "mark" information (e.g., timing information) that is "reserved" for use by the interactive processor so as to "link" the execution of the interactive application to the play of the A/V data stream [e.g., note paragraph 0011]. It is further noted that the event information is necessarily generated before the interactive event is executed by the processor in response thereto.

22. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 1.

23. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 9. Additionally:

As disclosed by of Newnam et al, the playlist includes at least "mark" information (e.g., timing information) that is "reserved" for use by the interactive processor [e.g., note paragraph 0011].

24. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 9. Additionally:

The examiner maintains that the claims are broad and fails to distinguish the claimed system over the prior art in which the processor is controlled to operate in synchronism with the playback of the A/V data stream via timing information provided by the playlist. More specifically, as disclosed by of Newnam et al, the playlist includes "mark" information (e.g., timing information) that is "reserved" for use by the interactive processor so as to "link" the execution of the interactive application to the play of the A/V data stream [e.g., note paragraph 0011]. It is further noted that the event information is necessarily generated before the interactive event is executed by the processor in response thereto

25. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 17. Additionally:

The examiner takes Official Notice that it was well known in the computer art to have used an "interrupt" configuration to synchronize the operation of a processor to an event/trigger so that the computer does not have to monitor the input for the occurrence of the trigger/event thereby allowing the processor to devote it time entirely to the execution of running applications. The examiner maintained that it would have been obvious to have further modified the admitted prior art to operate using the "interrupt" thereby advantageously providing a more efficient used of the available processing power of the processor.

26. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 1. Additionally:

The examiner takes Official Notice that it was well known in the computer art to have used an "interrupt" configuration to synchronize the operation of a processor to an event/trigger so that the computer does not have to monitor the

input for the occurrence of the trigger/event thereby allowing the processor to devote it time entirely to the execution of running applications. The examiner maintained that it would have been obvious to have further modified the admitted prior art to operate using the "interrupt" thereby advantageously providing a more efficient used of the available processing power of the processor.

27. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of "prior art", as set forth in lines 1-20 on page 1 of the instant specification (as originally filed), in view of US Patent document 2003/0189668 to Newnam et al. for the same reasons that were set forth above for claim 9. Additionally:

The examiner takes Official Notice that it was well known in the computer art to have used an "interrupt" configuration to synchronize the operation of a processor to an event/trigger so that the computer does not have to monitor the input for the occurrence of the trigger/event thereby allowing the processor to devote it time entirely to the execution of running applications. The examiner maintained that it would have been obvious to have further modified the admitted prior art to operate using the "interrupt" thereby advantageously providing a more efficient used of the available processing power of the processor.

28. The following references are noted:

A) US Patent Document #2006/0146660 to Ikeda et al.

Ikeda et al discloses a playback device as is illustrated in Figure 49 that includes a ***processor*** (@ 20), running a "Java" application, which receives both static and dynamic scenario information from a BD-ROM. As described the scenario information includes different "playlists" **[Note paragraphs 0096-0102 and 0251-0258]**, wherein the playlist includes PL Mark data representing "TimeEvents" that are to be executed by the Java application running on the processor in the synchronism with the playing video/audio stream **[Note paragraphs 0257-0258].**

B) US Patent Document #2003/0161615 to Tsumagari et al.

Tsumagari et al note that conventional DVD players are disadvantageous in that the management information thereon is fixed by the provider **[Note paragraphs 0062-0067].** To overcome this problem, Tsumagari et al describes modifying such system with circuitry, i.e., the ENAV circuitry of Figure 24, which permits new/separate management information to be downloaded from a server (e.g., @ 30W), to update/modify the playback/presentation of the A/V data without changing the data stream recorded/reproduced from the DVD **[Note paragraphs 0071, 0078, 0084, 0087, 0091, 0113, 0304, and 0370-0414].**

C) US Patent Document #2004/0175154 to Yoon et al.

Note paragraph 0060.

D) US Patent Document #2003/0229679 to Yoo et al.

Note paragraphs 0046-0051 and 0055-0056.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

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Primary Examiner
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